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| APPLICATION NO.         | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------|-------------|----------------------|---------------------|------------------|
| 10/785,647              | 02/24/2004  | David S. Benco       | LUTZ 2 00288        | 3711             |
| 48116 7590 03/04/2008   |             |                      |                     |                  |
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| EXAMINER                |             |                      |                     |                  |
| PATEL, HEMANT SHANTILAL |             |                      |                     |                  |
| ART UNIT                |             | PAPER NUMBER         |                     |                  |
| 2614                    |             |                      |                     |                  |
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| 03/04/2008              |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/785,647

**Applicant(s)**

BENCO ET AL.

**Examiner**

HEMANT PATEL

**Art Unit**

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claim 1 recites "second destination data of an IM message" in ll. 10. The specification does not describe IM message with more than one destination address. Claim 8 recites in ll. 3 "the second destination data" for IM message.
2. Claims 14, 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 14 recites system of claim 9 but the claim 9 recites method. Similarly claim 16 recites system of claim 11 but the claim 11 recites method.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
5. Claims 1-2, 4-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ye (US Patent No. 7,171,190 B2).

***Regarding claim 1,*** Ye teaches of a system wherein the instant messaging (IM) messages and short message service (SMS) messages are routed according to destination address i.e. SMS messages to cellular telephone number and email or IM messages to user email address or username (col. 3 ll. 6-13, ll. 28-35; col. 4 ll. 21-26; col. 5 ll. 8-13) and message is formatted (processed) if the sender and receiver message capabilities are not compatible (col. 6 ll. 5-27). Ye teaches of parsing incoming message for the destination address and processing the message when sending and receiving devices are incompatible and these devices are determined by the destination addresses used in the message (col. 3 ll. 4-6; col. 6 ll. 48-col. 7 ll. 15) (col. 2 ll. 58-col. 7 ll. 60). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ye to parse the destination data in the

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incoming message and check only the destination address format in the respective message and if it is not compatible, i.e. destination cellular phone number in incoming SMS or destination username or email address in incoming email or IM message, to process the message to make it compatible to the recipient capability so that "devices of different communication types may communicate using message delivery system" (Ye, col. 6 ll. 13-14) and "An SMS message specifying that an email be sent to user #2 may be used" (Ye, col. 7 ll. 30-31).

***Regarding claim 2,*** Ye teaches of a message switching element (Fig. 1 item 102, switches messages from sender to the receiver).

***Regarding claim 4,*** Ye teaches of a message router (Fig. 1 item 102; routes messages from sending device to the recipient device).

***Regarding claims 5, 6,*** Ye teaches of a message formatter (protocol converter) for converting SMS to IM and IM to SMS for delivering to their respective channel with determined communication type (wireless network or data network) (col. 6 ll. 5-27; col. 7 ll. 5-15).

***Regarding claims 7, 8,*** Ye teaches of sending incoming message in its original format based on the destination and its communication type if no conversion is required and this conversion determination is based on destination address i.e. SMS transmission through wireless for cellular phone and IM transmission to user computer (data network) for username (col. 3 ll. 3-13; col. 4 ll. 21-26; col. 5 ll. 8-15; col. 6 ll. 24-31).

**Regarding claim 9**, it recites a method for receiving SMS message and processing it if the destination in the message is not a telephone number substantially similar to the method performed by the system as claimed in claim

1. Refer to rejection for claim 1.

**Regarding claim 10**, refer to rejections for claim 9 and claim 7.

**Regarding claim 11**, it recites a method for receiving IM message and processing it if the destination in the message is not an e-mail address substantially similar to the method performed by the system as claimed in claim

1. Refer to rejection for claim 1.

**Regarding claim 12**, refer to rejections for claim 11 and claim 8.

**Regarding claim 13**, it recites a system, with means functions to receive and process SMS message if the destination in the SMS message is not the telephone number, substantially similar to the system as claimed in claim 1. Ye teaches of such a system with means (Fig. 1 items 10-40, 102; Fig. 3 items 302-310). Refer to rejection for claim 1.

**Regarding claim 14**, refer to rejections for claim 9 and claim 7.

**Regarding claim 15**, it recites a system, with means functions to receive and process IM message if the destination in the IM message is not an e-mail address, substantially similar to the system as claimed in claim 1. Ye teaches of such a system with means (Fig. 1 items 10-40, 102; Fig. 3 items 302-310). Refer to rejection for claim 1.

**Regarding claim 16**, refer to rejections for claim 11 and claim 8.

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6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ye as applied to claim 2 above, and further in view of Uchida (US Patent No. 7,072,359 B2).

**Regarding claim 3**, Ye teaches of a switching system for receiving, parsing and routing a message with protocol conversion if necessary. However, Ye does not teach that it is a mobile switching center.

However, in the same field of communication, Uchida teaches of a mobile switching center receiving short messages (SMS) , determining routing information for SMS messages and delivering them to proper serving nodes (col. 3 ll. 64-col. 4 ll. 8).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Ye's message processing functionality with Uchida's message processing in mobile switching center (MSC) in order to extend Ye's message processing functionality for incompatible messages "for techniques to convert GSM SMS messages to CDMA SMS messages, and vice versa" (Uchida, col. 2 ll. 7-9).

### **Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent Application Publication No. 2002/0087704

Chesnais

US Patent Application Publication No. 2002/0155826

Robinson

US Patent Application Publication No. 2002/0165000

Fok

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| US Patent Application Publication No. 2003/0003930 | Allison  |
| US Patent Application Publication No. 2003/0002633 | Kredo    |
| US Patent Application Publication No. 2003/0225850 | Teague   |
| US Patent No. 6,714,793                            | Carey    |
| US Patent Application Publication No. 2004/0058694 | Mendiola |
| US Patent Application Publication No. 2005/0037762 | Gurbani  |
| US Patent Application Publication No. 2005/0071434 | Hettish  |
| US Patent Application Publication No. 2005/0114533 | Hullfish |
| US Patent Application Publication No. 2005/0148351 | Reding   |

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HEMANT PATEL whose telephone number is (571)272-8620. The examiner can normally be reached on 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fan Tsang/  
Supervisory Patent Examiner, Art Unit 2614

Hemant Patel  
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HSP